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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/645,646	08/24/2000	Shimichiro Hayashi	13041.SUS01	3347

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EXAMINER

VO. HAI

ART UNIT	PAPER NUMBER
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1771

DATE MAILED: 10/22/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/645,646

Applicant(s)

HAYASHI ET AL.

Examiner

Hai Vo

Art Unit

1771

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 22 July 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 2,4,6-30 and 37 is/are pending in the application.
- 4a) Of the above claim(s) 27-29 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 2,4,6-26,30 and 37 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

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1. Claims 1, 5, and 31-36 have been canceled in the amendment received on 07/22/2003.

***Claim Objections***

2. Claims 18 and 22 are objected to because of the following informalities: the phrase "as measured according to JIS S 6050" needs to be added to the claims to commensurate in scope with the specification. Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 2-3, 6-10, 14-26, 30 and 37 are rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling. More particularly, the incorporation of the "porous structural material made from an organic polymer" as a "skeleton structure" is critical or essential to the practice of the invention as set forth in the specification at page 4, but not included in the claim(s) is not enabled by the disclosure. See In re Mayhew, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976).

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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6. Claims 2-3, 6-10, 14-26, 30 and 37 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claims 2 and 37, the phrases "skeleton portion" and "porous structural material" are unduly vague and indefinite <sup>as</sup> <sup>reading upon</sup> for example a piece of rock or a fabric. Further, the examiner suggests that product claims must be structurally distinguishable from the prior art. While features of a product may be recited either structurally or functionally, claims directed to a product must be distinguished from the prior art in terms of structure rather than function.

Claim 26 is confusing in that it appears to be some sort of "kit" claim. The examiner suggests the claim is rewritten in accordance with US Patent practice: a combination comprising an eraser set forth in claim 37 and an exchanging-use eraser that is selected from the group consisting of a feeding-type eraser, a knocking-type eraser, an eraser attached to an end of a mechanical pencil and an electric-type eraser.

#### ***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

#### ***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 2-4, 7-11, 14-25 and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Imashiro et al (US 5,413,853). Imashiro teaches each and every element of the presently claimed subject matter except an eraser used in the preamble of the claim (see paragraph no. 22 in the Office Action mailed on 01/22/2003). Although Imashiro fails to teach the melamine resin foam for use as an eraser, the melamine resin foam appears to be very fragile, which would make it an excellent eraser. The conventional eraser should exhibit a skeletal fracture during deformation by compression. The skeletal fracture of the melamine resin foam becomes part of an eraser scrap as the eraser is used. Further, the recitation "an eraser" has not given patentable weight because it has been held that a preamble is denied the effect of a limitation where the claim is drawn to a structure and the portion of the claim following the preamble is a self-contained description of the structure not depending for completeness upon the introductory clause. **Kropa v. Robie**, 88 USPQ 478 (CCPA 1951).

With regard to claim 24, Imashiro does not specifically disclose the foam porous plate comprising a plurality of blocks of porous structural

materials. However, the feature is known in the art to provide the foam plate with higher strength and dimensional stability.

With regard to claim 25, *In re Dailey*, 149 USPQ 47 (CCPA 1976), there is no evidence to show that the particular shape of the porous structural material is significant or is anything more than one of numerous shapes a person of ordinary skill in the art would find obvious for the purpose of providing the shape of the porous structural material, therefore, the shape of the porous structural material in itself would not render the claims patentable over Imashiro. See *Graham v. John Deere Co.*,

10. Claims 2-4, 7-11, 23 and 37 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Noboru (JP 08-258493) substantially as set forth in the Office Action mailed on 01/22/2003. Applicants argued that Noboru does not disclose or suggest a skeleton portion on an abrasion surface of the elastic material that is broken from the eraser by a deformation force. The examiner feels that the argument is not found persuasive for the following reasons. Noboru teaches the self-abrasive porous material impregnated with a plastisol (abstract, [0011]). Noboru teaches that the porous material has a skeleton structure (abstract). Therefore, the porous structure of Noboru would inherently include a skeleton portion and a void portion which is filled with the plastisol as presently claimed. Noboru discloses that the porous material wears as it undergoes scratching [0006]. Likewise, it is clearly apparent that the skeleton and the

impregnating elastic material are together broken from the eraser by the deformation force in accordance with Noboru's disclosure. It is the examiner's position that the skeleton portion would be inherently on an abrasion surface of the elastic material so that they are altogether separated at the same time from the eraser by a deformation force.

11. Claims 6 and 14-22, 24 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Noboru (JP 08-258493) substantially as set forth in the Office Action mailed on 01/22/2003. With regard to claims 24 and 25, the same reasons as set forth in paragraph no. 8 are believed to be pertinent.

12. Claims 26 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Noboru (JP 08-258493) in view of Stuzenegger (US 2,387,903) substantially as set forth in the Office Action mailed on 01/22/2003. See the reasons set forth in paragraph no. 10 are believed to be pertinent.

### ***Conclusion***

13. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

CFR 1.136(a) will be calculated from the mailing date of the advisory action.

In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hai Vo whose telephone number is (703) 605-4426. The examiner can normally be reached on M,T,Th, F, 8:30-6:00 and on alternating Wednesdays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on (703) 308-2414. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

HV

DANIEL ZIRKER  
PRIMARY EXAMINER  
GROUP 1800  
1700

*Daniel Zinker*